

**REMARKS**

Applicants acknowledge receipt of the Final Office Action mailed September 2, 2009.

In the Final Office Action, the Examiner rejected claims 75 and 90-101 under 35 U.S.C. § 102(b) as being anticipated by *Richards et al.* (U.S. Patent No. 6,296,809); rejected claims 102-113, 116-118, 120, and 121 under 35 U.S.C. § 103(a) as being unpatentable over *Richards* in view of *Ammann et al.* (U.S. Patent Pub. No. 2005/0233370); rejected claims 75 and 90-101 under 35 U.S.C. § 103(a) as being unpatentable over *Richards* in view of *Kalra et al.* (U.S. Patent No. 6,495,106); rejected claims 102-113, 116-118, 120, and 121 under 35 U.S.C. § 103(a) as being unpatentable over *Richards* in view of *Ammann* and *Kalra*; rejected claim 114 under 35 U.S.C. § 103(a) as being unpatentable over *Richards* in view of *Kalra*, and further in view of *Gonska et al.* (U.S. Patent No. 6,568,770); and rejected claims 115 and 119 under 35 U.S.C. § 103(a) as being unpatentable over *Richards* in view of *Amman* and *Kalra*, and further in view of *Gonska*.

By this Amendment, Applicants amend claims 75, 102, and 118, and cancel claims 114, 115, and 119, without prejudice or disclaimer. Claims 75, 90-113, 116-118, 120, and 121 remain pending. Of these claims, claims 75, 102, and 118 are independent.

Applicants traverse the rejections above and respectfully request reconsideration for at least the reasons that follow.

**I. 35 U.S.C. § 102(b) REJECTION**

Applicants traverse the rejection of claims 75 and 90-101 under 35 U.S.C. § 102(b) as being anticipated by *Richards*.

In order to properly establish that *Richards* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims must be disclosed, either expressly or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

The Examiner contends that the Applicant has failed to point to any particular structure (or lack of structure) in *Richards* that prohibits the claimed "wherein the carrier is inserted or removed during the processing protocol without interrupting a processing of another sample." (*Final Office Action*, p. 12). Moreover, the Examiner assumes that "since each slide is independently and removeably mounted over a different thermal platform, it is understood that each slide may be inserted or removed at any time without interrupting a processing of another sample." *Id.* It is not that simple, however. *Richards* only discloses an apparatus that is a rotating carousel that must be stopped before a carrier is inserted or removed during a processing protocol. Stopping the carousel disclosed in *Richards* interrupts the processing of another sample since the carousel must rotate to apply reagent to the next sample within a defined processing time. There is no disclosure in *Richards* regarding how to overcome these limitations. Claim 75, however, has been amended to include structure that allows the intended processing as claimed. With respect to independent claim 75, *Richards* fails to teach or

suggest this structure, such as, an automated sample processing system, comprising: "at least one removable reagent container positioned within a first plurality of drawers in a reagent section; [and] carrier retention devices for retaining said sample during said processing, the devices being positioned within a second and a third plurality of drawers in at least two carrier sections, respectively, the at least two carrier sections being separated by the reagent section . . . , wherein the carrier is inserted or removed during the processing protocol without interrupting a processing of another sample."

*Richards* therefore fails to disclose each and every element of the claims, either expressly or inherently. See M.P.E.P. § 2131. Accordingly, independent claim 75, and claims 90-101 which depend from claim 75, are patentable over *Richards*. Applicants therefore request that the rejection of claims 75 and 90-101 under 35 U.S.C. § 102(b) be withdrawn.

## II. 35 U.S.C. § 103(a) REJECTIONS

Claims 102-113, 116-118, 120, and 121 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Richards* in view of *Ammann*. Applicants respectfully disagree with the Examiner's arguments and conclusions and submit that independent claims 102 and 118 distinguish over *Richards* and *Ammann* at least for the reasons described below.

With respect to independent claims 102 and 118, the Examiner admits that "Richards . . . does not expressly disclose that reagent temperature control elements are provided for regulating the temperature of reagents before they are applied to the sample." (*Final Office Action*, p. 5, II. 1-3). As discussed above, the Examiner further

admits that "Richards . . . does not expressly state that a drawer is provided for housing the carriers." (*Id.* at p. 9, ll. 5-6).

In order to cure the deficiencies of *Richards*, the Examiner relies on *Ammann* and alleges "Ammann teaches that thermoelectric modules and fan units provide the desired cooling capacity, and are capable of regulating the temperature of a plurality of reagents maintained in a plurality of containers." (*Final Office Action*, p. 5, ll. 9-11). Such teaching, even if disclosed in *Ammann*, which Applicants do not necessarily concede, however, fails to teach or suggest an automated sample processing system, comprising: "at least one container having a reagent therein positioned within a first plurality of drawers in a reagent section for application to said at least one sample during said processing; [and] carrier retention devices for retaining said sample during said processing, the devices being positioned within a second and a third plurality of drawers in at least two carrier sections, respectively, the at least two carrier sections being separated by the reagent section; . . . wherein the carrier is inserted or removed during the processing protocol without interrupting a processing of another sample," as recited in independent claim 102 and similarly independent claim 118.

The processing deck 200 in *Ammann* does not include a plurality of drawers for housing the reagent containers and the carrier retention devices, where the drawers for housing the carrier retention devices in the two carrier sections are separated by the drawers that house the reagent containers in the reagent section. *Ammann* also fails to disclose inserting or removing a carrier or reagent during a processing protocol without interrupting a processing of another sample. Thus, *Ammann* also fails to overcome the above noted shortcomings of *Richards*.

As explained above, the elements of independent claims 102 and 118 are neither taught nor suggested by the cited references and no reason has been clearly articulated as to why the claims would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for independent claims 102 and 118, and claims 103-113, 116, 117, 120, and 121 which correspondingly depend from claims 102 and 118. Claims 102-113, 116-118, 120, and 121 are therefore patentable over *Richards* and *Ammann*, and Applicants respectfully request that this rejection be withdrawn.

Claims 75 and 90-101 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Richards* in view of *Kalra*. Applicants respectfully disagree with the Examiner's arguments and conclusions and submit that independent claim 75 distinguishes over *Richards* and *Kalra* at least for the reasons described below. The deficiencies of *Richards* are discussed above.

With respect to *Kalra*, the Examiner alleges, "the *Kalra* reference has been provided as evidence that is it known in the art to insert/remove a sample carrier during processing without interrupting the processing of other samples." (*Final Office Action*, p. 7, II. 5-7).

*Kalra*, however, fails to teach or suggest an automated sample processing system, comprising: "at least one removable reagent container positioned within a first plurality of drawers in a reagent section; [and] carrier retention devices for retaining said sample during said processing, the devices being positioned within a second and a third plurality of drawers in at least two carrier sections, respectively, the at least two carrier

sections being separated by the reagent section; . . . wherein the carrier is inserted or removed during the processing protocol without interrupting a processing of another sample," as recited in independent claim 75.

The automated staining apparatus 10 of *Kalra* does not include a plurality of drawers for housing the reagent containers. Rather, *Kalra* discloses a reagent vial holder 120 in the form of a reagent vial rack for holding the reagent vials 110. (*Kalra*, col. 9, ll. 15-20). *Kalra* also does not disclose the automated staining apparatus 10 including a plurality of drawers for housing the carrier retention devices. Rather, *Kalra* discloses a slide holder occupied by four 10-well microscope slide trays 190, with each microscope slide 130 retained in the well in a predetermined location relative to the baseplate 22. (*Id.* at col. 9, ll. 25-32). Furthermore, *Kalra* fails to teach or suggest at least two carrier sections with a plurality of drawers housing the carrier retention devices being separated by the reagent section with the plurality of drawers housing the reagent containers. As illustrated in FIG. 1 of *Kalra*, to the right of the reagent vial holder 120 are the microscope slide trays 190. The reagent vial holder 120 does not separate two microscope slide holder sections. Moreover, *Kalra* fails to teach or suggest inserting or removing a carrier during a processing protocol without interrupting a processing of another sample. Therefore, *Kalra* also fails to overcome the above noted shortcomings of *Richards*.

As explained above, the elements of independent claim 75 are neither taught nor suggested by the cited references and no reason has been clearly articulated as to why the claims would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for independent

claim 75, and claims 90-101 which depend from claim 75. Claims 75 and 90-101 are therefore patentable over *Richards* and *Kalra*, and Applicants respectfully request that this rejection be withdrawn.

Claims 102-113, 116-118, 120, and 121 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Richards* in view of *Ammann* and *Kalra*. Applicants respectfully disagree with the Examiner's arguments and conclusions and submit that independent claims 102 and 118 distinguish over *Richards*, *Ammann*, and *Kalra* at least for the reasons described below.

As discussed above, the Examiner admits that, "Richards . . . does not expressly disclose that reagent temperature control elements are provided for regulating the temperature of reagents before they are applied to the sample." (*Final Office Action*, p. 5, II. 1-3). Further, as reiterated above, the Examiner also admits that "Richards . . . does not expressly state that a drawer is provided for housing the carriers." (*Id.* at p. 9, II. 5-6).

In order to cure the deficiencies of *Richards*, the Examiner relies on *Ammann* and *Kalra* and alleges "Ammann teaches that thermoelectric modules and fan units provide the desired cooling capacity, and are capable of regulating the temperature of a plurality of reagents maintained in a plurality of containers" (*Final Office Action*, p. 5, II. 9-11), and "[c]olumn 17, lines 54-61 [of *Kalra*] states that slides can be removed from the system without interrupting the processing of remaining slides" (*Id.* at p. 8, II. 11-12).

As explained above, such teachings, even if disclosed in *Ammann* and *Kalra*, which Applicants do not necessarily concede, however, fail to teach or suggest, "at least

one container having a reagent therein positioned within a first plurality of drawers in a reagent section for application to said at least one sample during said processing; [and] carrier retention devices for retaining said sample during said processing, the devices being positioned within a second and a third plurality of drawers in at least two carrier sections, respectively, the at least two carrier sections being separated by the reagent section; . . . wherein the carrier is inserted or removed during the processing protocol without interrupting a processing of another sample," as recited in independent claim 102 and similarly independent claim 118. Thus, *Ammann* and *Kalra* also fail to overcome the above noted shortcomings of *Richards*.

As explained above, the elements of independent claims 102 and 118 are neither taught nor suggested by the cited references and no reason has been clearly articulated as to why the claims would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for independent claims 102 and 118, and claims 103-113, 116, 117, 120, and 121, which correspondingly depend from claims 102 and 118. Claims 102-113, 116-118, 120, and 121 are therefore patentable over *Richards*, *Ammann*, and *Kalra*. Applicants respectfully request that this rejection be withdrawn.

Claim 114 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Richards* in view of *Kalra*, and further in view of *Gonska*; and claims 115 and 119 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Richards* in view of *Amman* and *Kalra*, and further in view of *Gonska*. Applicants submit that the rejection of claims 114, 115, and 119 has been rendered moot by the cancellation of those

claims. Applicants therefore request that the rejection of claims 114, 115, and 119 under 35 U.S.C. § 103(a) be withdrawn.

### III. CONCLUSION

Applicants respectfully submit that claims 75, 90-113, 116-118, 120, and 121 are in condition for allowance.

The Final Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Final Office Action.

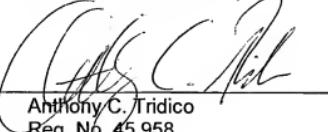
In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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